

Remarks

Claims 1 - 23 and 33-41 are active. Claims 24-32 are canceled. Claims 33 – 41 are added. Claims 1-32 are subject to restriction with claims 1-23 and 24-32 withdrawn from consideration. Claims 33-41 depend from claim 1. Claim 22 is rejected under 35 USC 102 as being anticipated by Figiluzzi '587 and Thomason '787. Claims 17-21 are rejected under 35 USC 103 as being obvious over '587 in view of Hughey '945. Claims 17-21 are rejected under 35 USC 103 as obvious over Thomason '787 in view of '945. Claim 23 is rejected under 35 USC 103 as being unpatentable over '587.

The Restriction

Group I - Claims 1-16 drawn to a thin film sheet

Group II - Claims 17-23 drawn to an electrical tape

Group III - Claims 24-32 drawn to a method of splicing an electrical cable.

Claims 1-16 and 24-32 are withdrawn from further consideration.

Since new claims 33-41 depend from claim 1, these claims should be grouped in Group I.

Amended claims 1-23 and new claims 33-41 are presented for the Examiner's reconsideration, claims 24-32 being canceled. Claims 33-41 do not present new matter. Support for new claims 33-35 is found in the text, paragraph [0050], page 14 and paragraph [0057] on page 17, first paragraph, lines 2-6. Support for the remaining new claims may be found at least in the various figures.

Amended claim 1 calls for:

A roll of thin film sheet material comprising;

a length of thin film sheet material adhered to itself on the outer surface thereof forming a spiral roll of overlying multiple layers extending from an innermost layer to an outermost layer, the innermost layer terminating at a first end and the outermost layer terminating at a second end, the second

end forming a free end terminating at an edge on the outermost layer of the roll, the edge overlying the outer surface of the next adjacent radially inward layer; and

visually observable indicia arranged in a plurality of substantially continuous adjacent side by side patterns extending substantially from the first end to the second end on the sheet material outer surface wherein at least one of the patterns at the second free end edge is misregistered with the at least one pattern on the portion of the next adjacent radially inward juxtaposed layer to thereby make the second free end edge visually observable.

Amended claim 17 calls for:

A roll of tape comprising:

a length of electrically insulating sheet material of a uniform color adhered to itself in a spiral roll of overlying multiple layers, the layers extending from a first end interior the roll to a second free end terminating at an edge on the outermost layer of the roll, the edge overlying the outer surface of the next adjacent radially inward layer;
an adhesive coating on one side of the material; and

a pattern comprising at least two spaced apart lines on a side of the material opposite the one side, each line extending from the first to the second ends, each line having a color different than the uniform color.

Claim 22 calls for:

An adhesive tape comprising:

a spiral layer of electrically insulating sheet material of a first color formed into a spiral roll of the material having opposing ends, the material having an adhesive coating on one surface thereof; and
an indicia pattern at a material outer surface comprising a plurality of side by side lines extending from end to end, thereon each line in a single second color different than the first color of the sheet material.

Applicant respectively traverses the restriction of Groups I and II as applied to amended claims 1, 17 and 22. Plainly, claim 22 is not directed to an electrical tape as asserted, but an adhesive tape. The restriction of the claims of Groups I and II is based on the assertion that the inventions I and II are related as mutually exclusive species in

an intermediate-final product relationship. As amended the material of claim 1 is directed to a roll of the material. This is not a substantive change of the claim, as the original claim 1 called for the material to be formed into a spiral roll.

An example is given by the Action that the intermediate product is claim 1, the thin film sheet, is useful as a decorative wrapping and the inventions are not obvious variants of each other. Applicant traverses the former conclusion. There is no basis in fact for concluding that the tape of claims 17 and 22, the former of which no longer relates to an electrical tape, but a roll of tape, which was always the case for claim 22, could also not be used as a decorative wrap. This conclusion is not sound. A roll of tape may also be used as a decorative wrapping. These are not good examples of mutually exclusive uses. No convincing line of reasoning is given as to why tape, made decorative, could not be so used as a wrapping.

MPEP 806.04(b), cited by the Action as support for this conclusion, states:

"Where species under a claimed genus are not connected in any of design, operation, or effect under the disclosure, the species are independent inventions."

Plainly, the so called species of claims 1, 17 and 22 have a common design, operation and effect, i.e., the patterns of claims 1, 17 and 22 for determining the edge of the material on a roll, and thus should not be deemed independent inventions.

Claim 1, amended, calls for: "a length of thin film sheet material adhered to itself on the outer surface thereof forming a spiral roll"

Claim 17, amended, calls for: "a length of electrically insulating sheet material of a uniform color adhered to itself in a spiral roll"

Claim 22, amended, call for: " a spiral layer of electrically insulating sheet material of a first color formed into a spiral roll of the material having opposing ends"

It is not seen that the term "thin film" in claim 1 and "electrically insulating" in claims 17 and 22 give rise to a basis for restriction. These are differences without distinction in the sense of deeming the claims independent of each other for purposes of restriction. Claim 1 is broader than claim 17, and claim 22 is broader than either of these other claims, but breadth per se is not a basis for restriction. The sheet of material of claims 17 and 22 could also be a thin film sheet. The term "electrically insulating" is a mere narrowing of the sheet material term and could also be a characteristic of the thin film of claim 1. A mere narrowing of a term is insufficient basis to support a restriction. Further claim 17 calls for an adhesive layer and claim 22 calls for an adhesive coating. This too is a narrowing of the claims and not sufficient to support a restriction.

Further the claims must be mutually exclusive to support a restriction. The MPEP states the determination of restriction must be made by both the practice applicable to election of species and other types of restrictions covered in MPEP . . . 806.05(j). Also MPEP 806.04(b) states that the intermediate and final products must not overlap in scope to show distinction. As pointed out above, claims 1, 17 and 22 overlap in scope.

Claim 1 calls for:

visually observable indicia arranged in a plurality of substantially continuous adjacent side by side patterns extending substantially from the first end to the second end on the sheet material outer surface

Claim 17 calls for:

a pattern comprising at least two spaced apart lines on a side of the material opposite the one side, each line extending from the first to the second ends, each line having a color different than the uniform color.

Claim 22 calls for:

an indicia pattern at a material outer surface comprising a plurality of side by side lines extending from end to end, each line in a single second color different than the first color of the sheet material.

Plainly, it appears from the above clauses the three claims overlap in scope which makes their restriction improper. These claims are not mutually exclusive as required by the MPEP. MPEP 806.05(j) states the inventions are distinct if:

- A) If the inventions as claimed do not overlap
- B) the inventions as claimed are not obvious variants
- C) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function or effect.

Items A and C clearly apply to claims 1 and 17 and it is left to the Examiner as to whether item B is applicable. Since at least items A and C apply it is believed that the restriction is not warranted and should be withdrawn as to these claims.

The Examiner's attention is brought to the fact that original and present withdrawn claim 3 calls for the film to have an adhesive, (the same as occurs in the tape of claim 17) and restricted claim 8 called for an electrical tape (the same as claim 17) which show there is no distinction in fact between these claims and original claims 17 and 22. The restriction was and is improper as to these claims. As amended claim 6 also calls for a tape, the restriction as to this claim and claims 17 and 22 being improper. Certainly the use of a film and a tape are not mutually exclusive as required and one can be substituted for the other. No convincing line of reasoning is given supporting the correctness of the restriction. Applicant respectfully requests that the restriction be withdrawn for the reasons given.

The substantive rejection

Amended claim 1 calls for:

visually observable indicia arranged in a plurality of substantially continuous adjacent side by side patterns extending substantially from the first end to the second end on the sheet material outer surface wherein at least one of the patterns at the second free end edge is misregistered with the at least one pattern on the portion of the next adjacent radially inward juxtaposed layer to thereby make the second free end edge visually observable (underlining added)

None of the cited references disclose or suggest this structure. '578 discloses only a single line, not a plurality of continuous adjacent side by side patterns as claimed which extend from end to end of the roll of film. The single line may be straight or sinusoidal, but in either case is only one line. One line does not suggest plural lines, That is applicant's contribution not that of the reference. No motivation is provided in this reference to do what applicant is claiming in amended claim 1.

The '787 reference is also foreign to amended claim 1. This reference discloses parallel diagonal lines of limited length (not continuous from end to end as claimed) to cover each segment of bathroom tissue. The lines extend from corner to corner of the segments, overlap transversely only at the corners, or are offset at the corners (See the abstract). The diagonal lines extend from one edge and are discontinuous relative to the ends of the material roll in the reference and do not extend side by side from end to end on the roll. In all embodiments of Figs. 1-7, while the lines are of different shapes, the parallel lines extend from edge to edge across the material width and are discontinuous from one end of the roll to the other end. While the abstract states the markings extend continuously along the roll, what this means from the drawings is that after one pattern terminates, a further pattern commences and this repetition repeats along the length of the roll. However, claim 1 amended is different. This is not what is claimed in amended claim 1. Amended claim 1 is believed allowable.

Claim 17 calls for:

a pattern comprising at least two spaced apart lines on a side of the material opposite the one side, each line extending from the first to the second ends

Neither of the cited references discloses or suggests such a pattern. The diagonal lines of the '578 patent do not extend from a first end to a second end, they terminate at an edge in a repeating pattern. This is not what is claimed. Further, the amended claim 17 structure is somewhat similar to that in amended claim 1 discussed above and is believed allowable for similar reasons.

Claim 22

This claim calls for:

an indicia pattern at a material outer surface comprising a plurality of side by side lines extending from end to end, each line in a single second color different than the first color of the sheet material.

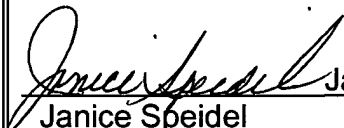
This structure is somewhat similar to that claimed in claims 1 and 17 and is believed allowable for similar reasons.

The remaining claims depend from allowable independent claims 1, 17 and 22, include all of the structure therein and are believed allowable for at least the same reasons as claims 1, 17 and 22.

Since claims 1-23 and 33-41 have been shown to be in proper form for allowance such action is respectfully requested.

No fee is believed due for this paper as the same number of active claims remain as in the filed application. However, the Commissioner is authorized to respectively

charge or credit deposit account 03 0678 for any under or overpayments in connection with this paper.

<u>FIRST CLASS CERTIFICATE</u>	
I hereby certify that this correspondence is being deposited on the date set forth below with the U.S. Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:	
Mail Stop Amendment Commissioner for Patents P.O. Box 1450 Alexandria VA 22313-1450	
 Janice Speidel	January 18, 2006 Date

Respectfully submitted,

Michael Albanese


By William Squire, Reg. No. 25,378

Attorney for Applicant

CARELLA, BYRNE, BAIN, GILFILLAN,
CECCHI, STEWART & OLSTEIN

5 Becker Farm Road

Roseland, NJ 07068

Tel. No.: (973) 994-1700

Fax No. : (973) 994-1744

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